

REMARKS

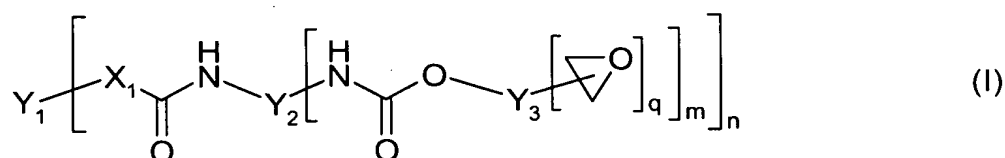
Claims 1-31 are pending in this application. Claims 1-21 and 27-31 have been withdrawn from consideration. In view of the following remarks, reconsideration and allowance of the claims are respectfully requested.

I. Rejection Under 35 U.S.C. §102

The Office Action rejects claims 22-25 under 35 U.S.C. §102(e) over U.S. Patent Application Publication No. 2003/0105266 to Suga ("Suga"). Applicants respectfully traverse the rejection.

Claim 22 recites:

An impact modifier terminated by epoxide groups of the formula (I)



in which:

X_1 is O, S or NH;

Y_1 is a n-valent radical of a reactive polymer after removal of the terminal amino, thiol or hydroxyl groups;

Y_2 is a divalent radical of aliphatic, cycloaliphatic, aromatic or araliphatic diisocyanates after removal of the isocyanate groups or is a trivalent radical of trimers or biurets of aliphatic, cycloaliphatic, aromatic or araliphatic diisocyanates after removal of the isocyanate groups;

Y_3 is a radical of an aliphatic, cycloaliphatic, aromatic or araliphatic epoxide containing a primary or secondary hydroxyl group after removal of the hydroxide and epoxide groups;

q is 2 or 3;

m is 1 or 2; and

n is 2, 3 or 4.

Suga fails to disclose at least each and every feature of claim 22.

Suga merely discloses a curable resin composition comprising a compound (B) having at least: (1) one blocked isocyanate group; and (2) one epoxy group (Suga, paragraph [0132]). Compound B can be obtained from a monomer (B-1) having these groups present and/or from a prepolymer (B-2) (Suga, paragraph [0133]). With respect to (B-1), Suga discloses that (B-1) is obtained by using a blocking agent to block the reaction product between: (1) an epoxy compound with a hydroxyl group; and (2) a polyisocyanate compound (Suga, paragraph [0136]; and Office Action, page 3). Such blocking agents include, phenol-, lactam -, oxime -, alcohol- and urea-based blocking agents (Suga, paragraphs [0067] and [0068]). As a result, because Suga discloses a resin composition comprising compound (B) having at least one blocked isocyanate group, the final composition will necessarily have various groups present, as originating from the blocking agent.

It is well settled that a claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. *See* MPEP §2131. Based on the above, Suga fails to disclose an impact modifier terminated by epoxide groups of the formula (I), as recited in claim 1. Instead, Suga discloses a curable resin composition comprising at least one blocked isocyanate group with an epoxy group.

In view of the foregoing, Suga fails to disclose each and every feature of claim 22 and, thus, does not anticipate claim 22. The remaining claims variously depend from claim 22 and, thus, are likewise not anticipated by Suga. Accordingly, reconsideration and withdrawal of the rejection are respectfully requested.

II. Rejection Under 35 U.S.C. §103

The Office Action rejects claims 22-24 and 26 under 35 U.S.C. §103(a) over U.S. Patent No. 5,484,853 to Chen et al. ("Chen") in view of U.S. Patent No. 3,505,283 to Dalhuisen ("Dalhuisen"). Applicants respectfully traverse the rejection.

For at least the reasons presented below, Chen and Dalhuisen, in combination, would not have rendered obvious at least each and every feature of claim 22.

The Office Action asserts that Chen discloses various features of claim 22, and concedes that Chen fails to disclose a specific compound that has more than one epoxy group (Office Action, page 5). The Office Action applies Dalhuisen to allegedly remedy the deficiencies of Chen, and asserts that Chen and Dalhuisen are allegedly analogous art and thus combinable in the manner asserted by the Office Action.

With reference to MPEP §2141.01(a), the standard for finding a reference to be analogous prior art is: "A reference in a field different from that of applicant's endeavor may be reasonably pertinent if it is one which, because of the matter with which it deals, logically would have commended itself to an inventor's attention in considering his or her invention as a whole." (Emphasis added). Dalhuisen is directed to one-component heat curing epoxy resins, as opposed to Chen, which is directed to two-part polyurethane adhesives. More specifically, Dalhuisen is focused on: (1) epoxy compositions having rapidly increasing viscosity; and (2) epoxy resins having carboxylic acid anhydride hardening agents, whereas Chen is focused on: (1) two-part urethane adhesive compositions with excellent thermal shock resistance; that (2) maintain adhesive strength through cryogenic temperature variations, such as from -198°C to 80°C (Dalhuisen, col. 1, lines 13-15, 42-47; and Chen, col. 1, line 15-17 and col. 2, lines 1-13). As a result, one of ordinary skill in the art of one-component heat curing epoxy resins would not look to Chen in considering his or her invention as a whole, based on these significant dissimilarities. Thus, Chen is not analogous art, and thus not properly combined with Dalhuisen.

In view of the foregoing, it would not have been obvious to one of ordinary skill in the art to have modified Dalhuisen or Chen without the benefit of Applicants' specification, at least because the references are not analogous art, and cannot reasonably be considered to

have provided any of the positively recited features of claim 22 with any reasonable expectations of success. Thus, Dalhuisen and Chen, individually or in combination, would not have rendered claim 22 obvious. The remaining claims variously depend from claim 22 and, thus, also would not have been rendered obvious. Accordingly, reconsideration and withdrawal of the rejection are respectfully requested.

III. Conclusion

In view of the foregoing, it is respectfully submitted that this application is in condition for allowance. Favorable reconsideration and prompt allowance of the application are earnestly solicited.

Should the Examiner believe that anything further would be desirable in order to place this application in even better condition for allowance, the Examiner is invited to contact the undersigned at the telephone number set forth below.

Respectfully submitted,



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